

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on January 14, 2005, and the references cited therewith.

No claims are amended, claims 1-16 are canceled, and claims 17-36 are added; as a result, claims 17-36 are now pending in this application.

Please cancel claims 1-16 without prejudice. Applicant is canceling claims 1-16 not to overcome a rejection in view of prior art, but rather to expedite prosecution because claims 1-16 have been found by the Examiner to be directed to non-statutory subject matter. In applicant's best judgment, replacing claims 1-16 with claims clearly drawn to statutory subject matter will save time and resources as compared to amending claims 1-16. Applicant has not cancelled or amended any particular limitations in claims 1-16 for reasons of patentability, nor to overcome any rejections in view of prior art. Accordingly, applicant respectfully believes that the cancellation of claims 1-16 and addition of new claims 17-36 does not create prosecution history estoppel that would bar application of the doctrine of equivalents at a later date.

§101 Rejection of the Claims

Claims 1-16 were rejected under 35 USC § 101 as being directed to non-statutory subject matter. Claims 1-16 have been canceled. Claims 17-36 have been added, and these claims are directed to methods and machine-readable medium, which are clearly directed to statutory subject matter.

At paragraph 20, the office action states "if the equation of page 22 is 'necessary' as stated in the specification page 22, then it appears that any claims without this equation may lack utility." Applicant respectfully submits that the application as filed does not state that the equation is necessary. Rather, the application states that "it is necessary to maintain the evenness of the number of legs". Applicant respectfully submits that the equation on page 21 may satisfy the evenness requirement, in which case, the equation on page 22 is not necessary. Further, the context of the "necessary" statement is confined to the "leg-splitting-calculating sub-arrangement" as described in the application as filed, and does not necessarily apply to all embodiments of the invention. Applicant respectfully submits that some embodiments of the

invention do not include the “leg-splitting-calculating sub-arrangement” and that in further embodiments, the leg-splitting-calculating sub-arrangement may “allow a user to stipulate an ‘X’-leg split for any given transistor re-legging candidate.” See page 23 lines 1 and 2 of the application as filed. Accordingly, applicant respectfully submits that all of the newly added claims, including those without an equation, have utility within the meaning of 35 USC § 101.

§112 Rejection of the Claims

Claims 1-16 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-16 have been canceled as described above. Claims 17-36 have been added. Applicant respectfully submits that the newly added claims are not indefinite under 35 USC § 112, second paragraph.

Regarding the comments of paragraphs 27, 28, and 30 of the office action, applicant has modified the usage of the terms in the equations as suggested by the Examiner. Applicant respectfully submits that these modifications overcome any rejection under 35 USC § 112, second paragraph.

At paragraph 29, the office action states “if the equation of page 22 is ‘necessary’ as stated in the specification, then it appears that any claims without this equation may lack utility.” Applicant respectfully submits that the claims without this equation do not lack utility. See the remarks above under the heading “§ 101 Rejection of the Claims.”

Art Cited but not used for Rejection

US patent 6,823,500 B1 has been reviewed by applicant. Applicant respectfully believes that the new independent claims are novel and non-obvious in view of US patent 6,823,500 B1.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (952-473-8800) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-2359.

Respectfully submitted,

SHMUEL WIMER

By his Representatives,

CUSTOMER NUMBER: 45445
952-473-8800

Date 4-14-05

By Dana B. LeMoine
Dana B. LeMoine
Reg. No. 40,062

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 14 day of April, 2005.

Chris Hammond
Name

Chris Hammond
Signature